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Danny Charles Bowman

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EXAMINER

GAKH, YELENA G

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANNY CHARLES BOWMAN,
JASON THOMAS BOWMAN,
DAVID MIKE LEWIS, and
RICHARD KIM PAISLEY

Appeal 2009-2011
Application 09/737,185
Technology Center 1700

Decided: April 20, 2009

Before ADRIENE LEPIANE HANLON, CATHERINE Q. TIMM, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Our review of the record leads us to conclude that this appeal is not
ripe for a decision on the merits.

Among the rejections to be reviewed is a rejection of claims 1-21 and 40-44 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. To support the rejection, the Examiner states that “[a]ll independent claims recite ‘a diagnostic specimen system comprising a population of biomedical specimen collection vessels’ with the members of the population located in three different locations (a vessel distribution facility, a specimen collection facility, and a specimen testing laboratory).” (Office Action, mailed January 10, 2006, at 2; Ans. 5). The Examiner then provides an analysis of the indefiniteness question that focuses upon the meaning of the above quoted language. (Office Action, mailed January 10, 2006, at 3; Ans. 5-6).

The problem is that not all of the rejected claims include the language quoted by the Examiner, nor does the quoted language adequately reflect a limitation shared by all rejected claims such that the question of indefiniteness applies equally to each claim. For example, claims 18, 19, and 44 are directed to methods for storing or recording information rather than “a diagnostic specimen system.” As another example, claim 43 is directed to “a toxicology specimen system” that requires just one “collection vessel” rather than “a population” of collection vessels. Even in the claims that recite “a diagnostic specimen system comprising a population of biomedical specimen collection vessels,” there are context and language differences that affect claim meaning and clarity. For instance, unlike claims 9, 17, and 18, which recite that the population of collection vessels includes “members” located at and transportable between the various facilities, claims 1 and 8 recite that “the population” is located at the various

facilities. The differences in claim language must be considered in determining whether a particular claim is indefinite or “particularly point[s] out and distinctly claim[s] the subject matter which applicant regards as the invention.” 35 U.S.C. § 112, second paragraph.

An analysis of claim indefiniteness under § 112 ¶ 2 is “inextricably intertwined with claim construction.” *Energizer Holdings, Inc. v. ITC*, 435 F.3d 1366, 1368-69 (Fed. Cir. 2006) (quoting *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1379 (Fed. Cir. 1999)); *see also Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1319 (Fed. Cir. 2008) (“Indefiniteness is a matter of claim construction, and the same principles that generally govern claim construction are applicable.”). Therefore, differences between claims with regard to claim scope and meaning must be accounted for in the indefiniteness analysis.

In order for an appellate body “to fulfill its role of judicial review, it must have a clear understanding of the grounds for the decision being reviewed.” *Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997). In the present case, we do not have the required clear understanding of the Examiner’s grounds for the decision, i.e., the grounds for rejecting claims 1-21 and 40-44 under 35 U.S.C. § 112, ¶ 2, because the indefiniteness analysis does not adequately focus on the specific language in each of claims 1-21 and 40-44, nor focus on a shared limitation with shared scope within all the rejected claims.

The appeal is not ripe for review for an additional reason. In responding to the Examiner’s rejection and in presenting issues for appeal, Appellants’ Brief does not address the fact that the claim limitations are different in each independent claim and does not group the claims

accordingly. (*See* App. Br. 16-21). The circumstances of this case prevent us from properly grouping the rejected claims in accordance with 37 C.F.R. § 41.37(c)(1)(vii). When an appellant has appealed a particular, properly defined ground of rejection, but has not argued for the separate consideration of any claims apart from the others, we may select a single representative claim to decide the issues for each ground of rejection in accordance with 37 CFR § 41.37(c)(1)(vii) and decide the appeal as to that claim alone. *Hyatt v. Dudas*, 551 F.3d 1307, 1312 (Fed. Cir. 2008). However, the prerequisite is that the grounds of rejection must be *properly defined* by the examiner. Here, because the Examiner did not properly treat claims with different limitations separately, the Examiner has not properly defined the grounds of rejection. *See Id.* (a “ground of rejection,” is “not merely the statutory requirement for patentability that a claim fails to meet but also the precise reason why the claim fails that requirement.”).

On remand, the Examiner shall present properly defined grounds of rejection for each of the rejected claims. In presenting the properly defined grounds, the Examiner shall consider the scope of each of the independent claims and determine indefiniteness based upon the specific limitations of each claim taking into account the statutory class differences between the system and method claims, the context and arrangement of the words, and the meaning of the specific words in each claim. *See In re Kuehl*, 475 F.2d 658, 664 (CCPA 1973) (“each statutory class of claims must be considered independently on its own merits.”); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972) (A process is a series of acts); *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863) (a “machine” is a concrete thing); *In re Nuijten*, 500 F.3d 1346, 1356 (Fed. Cir. 2007) (an article of manufacture is a tangible article or

commodity); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (“the context in which a term is used in the asserted claim can be highly instructive.”); *In re Hyatt*, 708 F.2d 712, 714 (Fed. Cir. 1983) (“A claim must be read in accordance with the precepts of English grammar.”); *IPXL Holdings L.L.C. v. Amazon, Inc.*, 430 F.3d 1377, 1383-84 (Fed. Cir. 2005) (“A claim is considered indefinite if it does not reasonably apprise those skilled in the art of its scope.”).

Accordingly, this appeal is not ripe for review, and we remand for further consideration of the rejections and clarification of the record.

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this Remand by the Board. A supplemental examiner's answer may include a new ground of rejection, but it must be made in accordance with the requirements enunciated in MPEP § 1207.03(I)(8th ed., Rev. 7, July 2008). If the Examiner files a supplemental examiner's answer, Appellants must respond by either requesting reopening of prosecution before the Examiner or by filing a reply brief to maintain the appeal. 37 C.F.R. § 41.50(a)(2) (2007). To avoid confusion, the reply brief must stand in place of the Brief and address each ground of rejection enunciated in the supplemental answer in accordance with 37 C.F.R. § 41.37.

We ORDER this application

REMANDED TO THE EXAMINER

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